

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

) Confirmation No.: 1214
)
Applicants: WILCE et al.) Group Art Unit: 3692
)
Application No.: 09/929,184) Examiner: Jennifer Liversedge
)
Filing Date: 8/14/2001) APPEAL BRIEF
)
For: SYSTEMS AND METHODS FOR) Attorney Docket No.: G08.002
FACILITATING AGREEMENT)
GENERATION AND) PTO Customer Number 28062
NEGOTIATION VIA AN) Buckley, Maschoff & Talwalkar LLC
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Mail Stop Appeal Brief – Patents (via EFS)
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants hereby submit an appeal to the Board of Patent Appeals and Interferences from the decision of the Examiner in the Final Office Action mailed December 15, 2006 (the “Final Office Action”) rejecting claims 1 and 3-19.

REAL PARTY IN INTEREST

The present application is assigned to GOLDMAN, SACHS & CO., 85 Broad Street, New York, New York 10004, U.S.A.

RELATED APPEALS AND INTERFERENCES

No other appeals or interferences are known to Applicants or Applicants' legal representative which will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal. The present application has not been assigned to any other party.

STATUS OF CLAIMS

Claims 2 and 20-29 have been canceled.

Claims 1 and 3-19 are being appealed.

STATUS OF AMENDMENTS

No amendments have been filed subsequent to the Final Office Action.

SUMMARY OF THE CLAIMED SUBJECT MATTER

Some of the claimed embodiments are directed to systems and methods to facilitate the generation and negotiation of agreement documents between a party and a counter-party. For example, an agreement document might relate to an exchange of financial products or credit limits between the parties. Specification at page 7, lines 8 to 20. Note that such agreements may

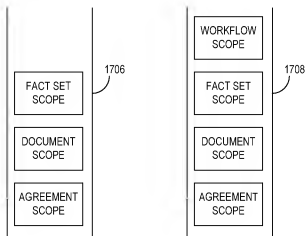
include flexible terms and conditions that change over time or between subsequent generations of the agreement documents. Specification at page 2, line 25 to page 3, line 6.

Claim 1

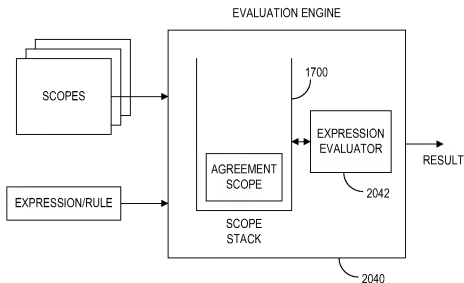
Claim 1 is directed to a method of facilitating generation of an agreement document associated with a financial transaction agreement between a party and a counter-party. Initially agreement information is received from a user associated with the party, including a counter-party communication address (e.g., an email address) and information about a financial product associated with the financial transaction agreement (e.g., a stock identifier). See, for example, the Specification at page 18, lines 14 to 27.

An agreement scope, a document scope, and a fact set scope are then determined in connection with the agreement. An “agreement scope” may comprise, for example, related fact sets that are used to create an agreement. Specification at page 34, lines 14 to 20. A “document scope” may comprise, for example, facts that are defined by a documents primary fact set as identified as an attribute of the associated document type. Specification at page 34, lines 21 to 25. A “fact set scope” may comprise, for example, a set of facts that are define by the current fact set (and more than one fact set scope might be active). Specification at page 34, line 26 to page 35, line 2.

The determined agreement scope, document scope, and fact set scope may then be placed in a scope stack. For example, FIG. 18 of the present application illustrates an agreement scope, a document scope, and a fact set scope placed in scope stacks 1706, 1708:



The scope stack is the evaluated via an evaluation engine to produce a result in accordance with a rule. For example, FIG. 17 of the present application illustrates an evaluation engine 2040 that evaluates a scope stack 1700 to generate a result in accordance with a rule:



The rule may, for example, provide a “true” or “false” result based on the information in scope stack 1700. Specification at page 32, line 26 to page 33, line 22.

The agreement document is generated in accordance with the information about the financial product, a covered products matrix, and the result. For example, an agreement modeling system may generate a MICROSOFT WORD® file based at least in part on the result. Specification at page 8, lines 16 to 18. The agreement document can then be automatically transmitted to the counter-party via the counter-party communication address. For example, the document file might be emailed to a device associated with the counter-party. Specification at page 8, lines 19 to 22.

Claim 16

Claim 16 is directed to an apparatus to facilitate generation of an agreement document associated with a financial transaction agreement between a party and a counter-party. Initially agreement information is received from a user associated with the party, including a counter-party communication address (e.g., an email address) and information about a financial product

associated with the financial transaction agreement (e.g., a stock identifier). See, for example, the Specification at page 18, lines 14 to 27.

An agreement scope, a document scope, and a fact set scope are then determined in connection with the agreement. An “agreement scope” may comprise, for example, related fact sets that are used to create an agreement. Specification at page 34, lines 14 to 20. A “document scope” may comprise, for example, facts that are defined by a documents primary fact set as identified as an attribute of the associated document type. Specification at page 34, lines 21 to 25. A “fact set scope” may comprise, for example, a set of facts that are define by the current fact set (and more than one fact set scope might be active). Specification at page 34, line 26 to page 35, line 2.

The determined agreement scope, document scope, and fact set scope may then be placed in a scope stack. For example, FIG. 18 of the present application illustrates an agreement scope, a document scope, and a fact set scope placed in scope stacks 1706, 1708. The scope stack is the evaluated via an evaluation engine to produce a result in accordance with a rule. For example, FIG. 17 of the present application illustrates an evaluation engine 2040 that evaluates a scope stack 1700 to generate a result in accordance with a rule. The rule may, for example, provide a “true” or “false” result based on the information in scope stack 1700. Specification at page 32, line 26 to page 33, line 22.

The agreement document is generated in accordance with the information about the financial product, a covered products matrix, and the result. Specification at page 8, lines 16 to 18. The agreement document can then be automatically transmitted to the counter-party via the counter-party communication address. Specification at page 8, lines 19 to 22.

Claim 19

Claim 19 is directed to a medium storing instructions to perform a method of facilitating generation of an agreement document associated with a financial transaction agreement between a party and a counter-party. Initially agreement information is received from a user associated with the party, including a counter-party communication address (e.g., an email address) and information about a financial product associated with the financial transaction agreement (e.g., a stock identifier). See, for example, the Specification at page 18, lines 14 to 27.

An agreement scope, a document scope, and a fact set scope are then determined in connection with the agreement. An “agreement scope” may comprise, for example, related fact sets that are used to create an agreement. Specification at page 34, lines 14 to 20. A “document scope” may comprise, for example, facts that are defined by a documents primary fact set as identified as an attribute of the associated document type. Specification at page 34, lines 21 to 25. A “fact set scope” may comprise, for example, a set of facts that are define by the current fact set (and more than one fact set scope might be active). Specification at page 34, line 26 to page 35, line 2.

The determined agreement scope, document scope, and fact set scope may then be placed in a scope stack. For example, FIG. 18 of the present application illustrates an agreement scope, a document scope, and a fact set scope placed in scope stacks 1706, 1708. The scope stack is the evaluated via an evaluation engine to produce a result in accordance with a rule. For example, FIG. 17 of the present application illustrates an evaluation engine 2040 that evaluates a scope stack 1700 to generate a result in accordance with a rule. The rule may, for example, provide a “true” or “false” result based on the information in scope stack 1700. Specification at page 32, line 26 to page 33, line 22.

The agreement document is generated in accordance with the information about the financial product, a covered products matrix, and the result. Specification at page 8, lines 16 to 18. The agreement document can then be automatically transmitted to the counter-party via the counter-party communication address. Specification at page 8, lines 19 to 22.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1 and 3-19 are rejected under 35 USC 103 as being unpatentable over US Publication NO. 2002/0087534 (“Blackman”) in view of US Publication No. 2002/0188539 (“Axelrad”) and further in view of *Advanced Perl Programming* by Sriram Srinivasan (“the Perl reference”).

ARGUMENT

Claim 1 recites that agreement information is received from a user, including a counter-party communication address and information about a financial product associated with a financial transaction agreement.

Moreover, claim 1 recites “determining an agreement scope, a document scope, and a fact set scope” and “placing the determined agreement scope, document scope, and fact set scope in a scope stack.” The scope stack is evaluated “via an evaluation engine to produce a result in accordance with a rule.” The agreement document is then generated in accordance with the financial product, a covered products matrix, and “the result.”

The agreement document is then automatically transmitted to the counter-party via the counter-party communication address.

As acknowledged in the Final Office Action, neither Blackman nor Axel discloses placing an agreement scope, document scope, and fact scope in a scope stack nor evaluating the scope stack via an evaluation engine to produce a result in accordance with a rule. Final Office Action, page 4, last partial paragraph.

To overcome this deficiency in the references, the Final Office Action cites the Perl reference, and, in particular, page 3, lines 36-41 of the Perl reference. This portion of the Perl reference is set forth here in its entirety for convenience:

Scope stack /scopestack/

The scope stack is used to remember positions along the save stack that correspond to different scopes (analogous to the markstack providing bookmarks for the argument stack). When the scope ends (upon LEAVE), Perl knows exactly how many objects to pop off the save stack and restores them to their former values.

Appellants respectfully submit that the Perl reference does not disclose or suggest “determining an agreement scope, a document scope, and a fact set scope” nor “placing the determined agreement scope, document scope, and fact set scope in a scope stack.” Nor does the Perl reference disclose or suggest that such a scope stack is evaluated “via an evaluation engine to produce a result in accordance with a rule” as is recited in claim 1.

Because these features are entirely missing from the references cited by the Examiner, Appellants respectfully request reversal of the final rejection and allowance of claim 1.

Moreover, in rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. See In re Rijckaert, 9 F.3d 1531,1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A *prima facie* case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d1596, 1598 (Fed. Cir. 1988). Evidence of a suggestion, teaching, or motivation to modify a reference may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d1626, 1630 (Fed. Cir. 1996), although “the suggestion more often comes from the teachings of the pertinent references,” In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir.1998). The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. See, e.g., C.R.Bard Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir.1998), cert. denied, 119 S. Ct. 1804 (1999). A broad conclusory statement regarding the obviousness of modifying a reference, standing alone, is not evidence. Thus, when an Examiner relies on general knowledge to negate patentability, that knowledge must be articulated and placed on the record. See In re Lee, 277 F.3d 1338, 1342-45,61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002).

In the present case, there is simply no convincing argument that would lead to the conclusion that one of ordinary skill in the art would have been motivated to modify the reference in the way suggested by the Examiner.

The teaching or suggestion to make the claimed combination must be found in the prior art, and not based on the Applicants’ disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). “To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). The fact that references can

potentially be modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP 2143.01; In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); Monarch Knitting Machinery Corp. v. Sulzer Morat GmbH, 45 USPQ 2d 1977, 1981-82 (Fed. Cir. 1998) (the question to be asked is “whether the prior art contains a suggestion or motivation to combine references”).

The Final Office Action merely states that “[i]t would be obvious to one of ordinary skill in the art to combine the use of scope stacks as disclosed by Perl with the transaction agreement system as disclosed by Blackman and Axelrad. The motivation would be that the use of scope stacks are used to organize data related to scopes of defined fields and to use them in relation to evaluating data which has been collected and stored.” Final Office Action, paragraph spanning pages 4 and 5. Appellants respectfully do not understand how this would motivate one to produce the invention as it is specifically recited in claim 1. The absence of a motivation in the prior art (and the lack of a convincing line of reasoning) to modify the reference in the ways recited in the claim indicates that the Examiner has simply used the present invention as a motivation to modify the reference – the essence of impermissible hindsight reconstruction.

Because there is no teaching or suggestion to modify the reference in this way, a *prima facie* case of obviousness has not been established. The rejection of these claims should be reversed.

Claims 3-19 depend from claim 1, or contain limitations similar to those described above with respect to claim 1, and should therefore be allowable for at least the same reasons.

CONCLUSION

Appellants respectfully suggest that rejections of claims 1 and 2-19 are improper and request that the rejections be reversed. If any issues remain, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is kindly invited to contact the undersigned.

Respectfully submitted,

October 18, 2007
Date

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Appendix A - Claims
Appendix B - Evidence
Appendix C - Related Proceedings

APPENDIX A - CLAIMS

This is a complete copy of the claims involved in the appeal:

1. A method for facilitating generation of an agreement document associated with a financial transaction agreement between a party and a counter-party, comprising:
 - receiving agreement information from a user associated with the party, the agreement information including (i) a counter-party communication address and (ii) information about a financial product associated with the financial transaction agreement;
 - determining an agreement scope, a document scope, and a fact set scope;
 - placing the determined agreement scope, document scope, and fact set scope in a scope stack;
 - evaluating the scope stack via an evaluation engine to produce a result in accordance with a rule;
 - generating the agreement document in accordance with the information about the financial product, a covered products matrix, and the result; and
 - automatically transmitting the agreement document to the counter-party via the counter-party communication address.
3. The method of claim 1, wherein the counter-party communication address comprises at least one of: (i) an electronic mail address, (ii) an Internet address, (iii) a uniform resource locator, and (iv) a telephone number.
4. The method of claim 1, further comprising:
 - automatically transmitting the agreement document via a communication address associated with the party.

5. The method of claim 1, wherein the party is associated with a first party entity and a second party entity, and further comprising:

transmitting the agreement document via a first communication address associated with ~~at~~ the first party entity;

receiving information from the first party entity; and

transmitting the agreement document via a second communication address associated with ~~at~~ the second party entity.

6. The method of claim 1, wherein the agreement document comprises at least one of: (i) a final agreement document, and (ii) an amendment to an existing agreement document.

7. The method of claim 1, wherein the agreement document comprises a preliminary agreement document.

8. The method of claim 7, wherein said transmitting comprises automatically transmitting the preliminary agreement document via the counter-party communication address associated with the counter-party, and further comprising:

receiving a revised preliminary agreement document from the counter-party.

9. The method of claim 8, further comprising:

reconciling the revised preliminary agreement document and the preliminary agreement document; and

generating a final agreement document in accordance with said reconciliation.

10. The method of claim 1, where said generating comprises automatically generating a plurality of agreement documents in accordance with the information about the financial product, the covered products matrix, and the result.

11. The method of claim 1, wherein the agreement information comprises at least one of: (i) an agreement type, (ii) an agreement term, and (iii) an agreement fact.

12. The method of claim 1, wherein the agreement comprises a transaction agreement associated with at least one of: (i) a set of rights between the party and the counter-party, (ii) a legal contract, (iii) a financial instrument, and (iv) a monetary amount.

13. The method of claim 1, wherein the financial product comprises at least one of: (i) an equity product, (ii) a stock product, (iii) an index product, (iv) a fixed income product, (v) a bond product, (vi) a bank loan product, (vii) a whole loan product, (viii) an interest rate product, (ix) a credit derivative product, (x) a commodity product, (xi) a metal product, (xii) a energy product, and (xiii) an agriculture product.

14. The method of claim 1, wherein the financial transaction agreement is associated with at least one of: (i) a swap instrument, (ii) an option instrument, (iii) a buy instrument, (iv) a sell instrument, (v) a call instrument, (vi) a put instrument, (vii) a forward instrument, (viii) a pre-paid forward instrument, (ix) a spot instrument, (x) a repurchase agreement instrument, (xi) a loan instrument, (xii) a warrant instrument, and (xiii) a contract for differences instrument.

15. The method of claim 1, wherein said generating is performed via at least one of: (i) covered product matrix information retrieved from a database, (ii) a pre-stored default transaction term, (iii) information received from a user of an agreement modeling system, (iv) information received from a satellite system, and (v) information received from a legacy agreement system.

16. An apparatus for facilitating generation of an agreement document associated with a financial transaction agreement between a party and a counter-party, comprising:

a processor; and

a storage device in communication with said processor and storing instructions adapted to be executed by said processor to:

receive agreement information from a user associated with the party, the agreement information including (i) a counter-party communication address and (ii) information about a financial product associated with the financial transaction agreement,

determine an agreement scope, a document scope, and a fact set scope,

place the determined agreement scope, document scope, and fact set scope in a scope stack,

evaluate the scope stack via an evaluation engine to produce a result in accordance with a rule,

generate the agreement document in accordance with the information about the financial product, a covered products matrix, and the result, and

automatically transmit the agreement document to the counter-party via the counter-party communication address.

17. The apparatus of claim 16, wherein said storage device further stores an agreement information database.

18. The apparatus of claim 16, further comprising:

a communication device coupled to said processor and adapted to communicate with at least one of: (i) a client device, (ii) an agreement modeling system controller, (iii) a satellite system, and (iv) a counter-party device.

19. A medium storing instructions adapted to be executed by a processor to perform a method of facilitating generation of an agreement document associated with [an] a financial transaction agreement between a party and a counter-party, said method comprising:

receiving agreement information from a user associated with the party, the agreement information including (i) a counter-party communication address and (ii) information about a financial product associated with the financial transaction agreement;

determining an agreement scope, a document scope, and a fact set scope;

placing the determined agreement scope, document scope, and fact set scope in a scope stack;

evaluating the scope stack via an evaluation engine to produce a result in accordance with a rule;

generating the agreement document in accordance with the information about the financial product, a covered products matrix, and the result; and

automatically transmitting the agreement document to the counter-party via the counter-party communication address.

APPENDIX B - EVIDENCE

No evidence is submitted herewith (*i.e.*, this appendix is empty).

APPENDIX C - RELATED PROCEEDINGS

No other appeals or interferences are known to Applicants or Applicants' legal representative which will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal. The present application has not been assigned to any other party.

Therefore, there are no copies of decisions rendered by a court or the Board to attach (*i.e.*, this appendix is empty).